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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/691,027 | 10/21/2003 | John Hurd | 005127.00348 | 4984 |

22907 7590 02/25/2005

BANNER & WITCOFF
1001 G STREET N W
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WASHINGTON, DC 20001

EXAMINER

PATTERSON, MARIE D

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3728

DATE MAILED: 02/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-----------------|--------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/691,027 | HURD ET AL | |
| | Examiner | Art Unit | |
| | Marie Patterson | 3728 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>1/6/05&11/26/03</u> | 6) <input type="checkbox"/> Other: ____ |

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Claim Rejections - 35 USC § 112

1. Claims 1-33, 38, and 40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1 and 15 the phrase "wherein the arm moves..." and claims 6-8, 10, 14, 23-25, 27, 28, and 33 in their entirety are functional, indefinite, and incomplete because they contain functional language not supported by recitation in the claim of sufficient structure to warrant the presence of such language. (MPEP 2114) It is not clear what structural limitations applicant intends to encompass with such language.

In claim 19 the phrase "are relatively positioned so as to define a space for receiving a user's toes" is vague and indefinite because it is not clear what structural limitations applicant intends to encompass with such language.

Claims 38 and 40 do not recite any additional method steps and therefore it is not clear what steps applicant intends to encompass.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

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The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-6, 9-18, 20, 21, 23, 26-29, 32-35, and 37-40 are rejected under 35 U.S.C. 102(b) as being anticipated by Ogle (5282327).

Ogle shows a spring member (16 and 36), an arm (12/16), and a heel retaining element (14) and the inherent method of use as shown in the figures as claimed.

4. Claims 1-6, 9-18, 20, 21, 23, 26-29, 32-35, and 38-40 are rejected under 35 U.S.C. 102(b) as being anticipated by Dorr (2069752).

Dorr shows a spring member (28 and 29), an arm (21 and 24), and a heel retaining element (17) and the inherent method of use as shown in the figures as claimed.

5. Claims 1-7, 9-18, 20, 21, 23, 24, 26-30, 32-35 and 37-40 are rejected under 35 U.S.C. 102(b) as being anticipated by Balut (2693039).

Balut shows a spring member (28) with a hole (center of spiral form), an arm (side portions of elements 26), a heel retaining element (top of elements 26), an interface (24), a footbed (18), and a midsole (12) and the inherent method of use as shown in the figures as claimed.

6. Claims 1-6, 9-12, 14-23, 26-29, and 33-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Neiley (2002/0174568).

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Neiley shows a spring member (shown in figure 6) with an arm (front and rear portions), a heel retaining element (at 66), a toe retaining element (at 96 and/or 97) and the inherent method of use as shown in the figures as claimed.

7. Claims 1-3, 5, 6, 9, 10, 14-17, 20, 23, 26-29, 31, and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Miller (2746178).

Miller shows a spring member (figures 4 and 7), an arm (21 and 24), an outsole (21a) and midsole (20) as shown in the figures as claimed.


Allowable Subject Matter

8. Claims 8 and 25 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

1. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Other useful information can be obtained at the PTO Home Page at www.uspto.gov.

In order to avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at **(703) 872-9306 (FORMAL FAXES ONLY)**. Please identify Examiner Marie Patterson of Art Unit 3728 at the top of your cover sheet.

Any inquiry concerning the MERITS of this examination from the examiner should be directed to Marie Patterson whose telephone number is (571) 272-4559. The examiner can normally be reached from 6AM - 4PM Mon-Wed.


Marie Patterson
Primary Examiner
Art Unit 3728